REMARKS / ARGUMENTS

This application is believed to be in condition for allowance because the claims are non-obvious and patentable over the cited references. The following paragraphs provide the justification for this belief. In view of the following reasoning for allowance, the Applicant hereby respectfully requests further examination and reconsideration of the subject patent application.

1.0 Rejections under 35 U.S.C. §102(e):

In the Office Action of April 7, 2004, claims 1-9, 11, 13-15, 24-30, 34-45 and 50 were rejected under 35 U.S.C. §102(e), as being anticipated by Appelt at al. ("*Appelt,*" U.S. Patent 6,601,026). A rejection under 35 U.S.C. §102(e) requires that the Applicant's invention was described in patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant. To establish that a patent describes the Applicant's invention, *all of the claimed elements of an Applicant's invention must be considered, especially where they are missing from the prior art*. If a claimed element is not taught in the referenced patent, then a rejection under 35 U.S.C. §102(e) is not proper, as the Applicant's invention can be shown to be patentably distinct from the cited reference.

Further, in accordance with both the M.P.E.P., Chapter 2100, and well settled case law, the PTO is to apply to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, *taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification*" (emphasis added), in re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Further, *the claim must be interpreted in light of the teachings of the written description and purpose of the invention described therein*. Strattec Sec. Co. v. Gen. Auto. Specialty Co., Inc., 126 F.3d 1411, 1417, 44 USPQ2d 1030, 1034-5 (Fed. Cir. 1997).

10

Finally, as explained in Section 706.02 of the MPEP, in the section entitled "DISTINCTION BETWEEN 35 U.S.C.102 AND 103," the MPEP states that "The distinction between rejections based on 35 U.S.C.102 and those based on 35 U.S.C.103 should be kept in mind. Under the former, the claim is anticipated by the reference. *No question of obviousness is present*. In other words, for anticipation under 35 U.S.C.102, *the reference must teach every aspect of the claimed invention either explicitly or impliedly*. Any feature not directly taught must be inherently present." (emphasis added)

1.1 Rejection of Claim 1:

The Office Action rejected independent claim 1 under 35 U.S.C. §102(e) based on the rationale that the *Appelt* reference discloses the Applicant's claimed "...system for automatically alerting a user to available information..."

In particular, the Office Action cites *Appelt* as disclosing *automatically* "identifying at least one person represented by the identified data" and "retrieving information relating to each identified person from at least one electronic database." Further, with respect to the applicants claimed element of "retrieving information relating to each identified person from at least one electronic database," the Office Action suggests *Appelt* discloses a capability for *manual user queries* to initiate the retrieval of information. The Office Action then continues by suggesting that *Appelt* discloses a capability for automatically "notifying the user that the retrieved information is available" by simply sending the *manually requested* response to the user. Further, the Office Action cites *In re Venner*, 262 F. 2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) with a suggestion that Applicant is merely replacing manual activities described by *Appelt* with corresponding automatic activities. In particular, the Office Action suggests that Applicant is replacing the *manual user queries* described by *Appelt* for initiating the retrieval of information with the automatic retrieval of information described and claimed by the applicant.

In response, the Applicant would like to point out that *In re Venner* does *not* apply in the case where there is no equivalency between a manual step directed to one task, and

11

an automatic step directed towards performing a step having no commonality with the manual step, such as is the case here. Specifically, in stark contrast to the position advanced by the Office Action, the Applicants are not merely *automating* a step which was manually preformed by the *Appelt* reference, the Applicants are either *eliminating* steps, or performing different steps entirely. In other words, the Applicants claimed automatic steps are *not* automating the steps performed by *Appelt*, as there is no commonality between a number of the claimed steps of the Applicants invention and the *Appelt* reference. As a result, *In re Venner* is simply not applicable to the claims in this case.

In particular, as described in the Applicant's prior response, filed January 15, 2004, *Appelt* describes a system which retrieves data relating to one or more specific persons identified in a particular document only upon a *manual user query*. In other words, during the "set-up phase" described by *Appelt* in column 5, lines 37-43, an "information extraction engine parses free-text documents to identify topics... and objects... defined and constructed by an analyst when the system 100 is set up..." This information is then *extracted from the parsed documents*, then stored and organized in a database such as a relational database (see col. 5, line 37 to col. 6, line 3). The information extracted from the parsed documents for populating the query database is then made available to a user in response to manual user queries. In other words, Applicants respectfully suggest that *Appelt* does *not* retrieve "information relating to each identified person from at least one electronic database" as disclosed and claimed by the Applicants. In fact, *Appelt* is instead *retrieving the information directly from the parsed document and providing it to the database*.

In stark contrast to the system described by *Appelt*, the Applicant describes and claims a system wherein one or more persons are first *automatically* identified by parsing an electronic document. That information derived from parsing the document is then used to retrieve related information from at least one electronic database, as described in further detail below. Note that one major difference here between the claimed invention and that of *Appelt* is that *Appelt* is simply parsing a document in order to *extract information*

12

from that document based on a set of predefined rules, with the extracted information then being used to populate a database which is then made available for subsequent manual user queries.

Next, also in stark contrast to the system described by *Appelt*, the Applicant's claimed system *automatically* retrieves information relating to identified persons "from at least one electronic database." Again, one major difference here between the claimed invention and that of *Appelt* is that *Appelt* is *extracting* information from the parsed document to *populate a database* which is then made available for subsequent manual user queries. In contrast Applicant is claiming that one or more people are identified by parsing a document, and that information relating to each identified person is then automatically *retrieved from at least one electronic database*. In other words, at this point, the Applicant's claimed invention is *retrieving information from a database*, while *Appelt* is *populating a database*.

Consequently, in the case of the *Appelt* system, if the information relating to identified persons is not available in the parsed document, it will not then be available to the user via a manual user query. Clearly, this is completely different from the claimed case wherein information relating persons identified by parsing a document is automatically *retrieved* from one or more databases external to the parsed document. Again, rather than retrieving information relating to an identified person from a database, *Appelt* is *extracting* information from the parsed document and then *populating the database with that information*. Clearly, this system fails to describe the claimed element for which it is offered by the Office Action. Further, it appears that the Office Action has merely selected elements from the *Appelt* reference which merely sound similar to the elements of the claimed invention. However, when understood in their broadest interpretation and in their appropriate context, there is no commonality between the elements of the *Appelt* reference and those of the claimed invention.

For example, as clearly illustrated by Figure 2 of the Applicants patent application, and as explained by the Applicants in paragraphs 45-46:

"...the present invention uses the program modules illustrated in FIG. 2 to *automatically scan* or parse at least one electronic document 200 to find any data that represents at least one person using a scanning module 210. Once data representing a person has been found, an identification and data retrieval module 220 *automatically identifies the person* represented by the data by comparing that data to information contained in at least one ... electronic database... then *automatically retrieves data* ... from at least one ... electronic databases... Finally, once the relevant data for the person has been retrieved, an alert module 250 *automatically notifies the user*, via a visible or audible alert, *that the person has been identified, and that information relevant to that person is available.*" (emphasis added)

Similarly, as discussed in paragraph 54 with respect to Figure 3, the Applicants explain that "once a person has been identified (Box 350), data or information relevant to that person is *automatically retrieved* (Box 360) from at least one electronic database" (emphasis added).

Consequently, as previously explained by the Applicant in the response filed January 15, 2004, one clear advantage of the Applicants invention over the invention disclosed by *Appelt* is that, unlike *Appelt*, the Applicants do *not* require a user to manually format and enter query strings for locating and retrieving information relating to particular identified persons. In fact, rather than being forced to manually enter query strings for retrieving data, the user is simply *automatically* notified of the availability of data relating to each identified person once it is automatically retrieved from one or more electronic databases.

Next, as noted above, the Applicant's claimed system automatically *alerts* a user as to the availability of the data that is automatically retrieved from the at least one database following an automatic parsing of an electronic document to identify one or more people. However, as previously explained by the Applicant in the response filed January 15, 2004, the Applicants respectfully suggest that those skilled in the art would not interpret *Appelt's*

capability to provide a *response to a manually entered user query* relating to information extracted from a parsed document as disclosing an *automatic notification of available data* that is automatically retrieved from at least one electronic database as disclosed and claimed by the Applicants.

In addition to the above described claim elements, the Applicant has also amended independent claim 1 to further clarify the scope of claim 1. In particular, the Applicant has amended claim 1 to further include an element which recites that at least a portion of the retrieved information is used to provide at least one electronic interface for initiating communication with persons identified through parsing of the electronic document. This element is also not taught by the Appelt reference.

Therefore, in view of the preceding discussion, it is clear that the present invention, as claimed by independent claim 1, has elements not taught in the *Appelt* reference. Consequently, the rejection of claim 1 under 35 U.S.C. §102(e) is not proper. Therefore, the Applicants respectfully request reconsideration of the rejection of claim 1, as amended, and thus of dependent claims 2, 4-9, 11, and 13-15 under 35 U.S.C. §102(e) in view of the novel language of claim 1, as cited below:

A system for automatically alerting a user to available information comprising:

parsing an electronic document, said electronic documents including any of a word processor document, an Internet Web page, a spreadsheet, and any textual and graphical data rendered on a display device, to identify data representing any person;

identifying at least one person represented by the identified data;

retrieving information relating to each identified person from at least one electronic database;

notifying the user that the retrieved information is available; and

using at least a portion of the retrieved information relating to one or more of the identified persons *to provide at least one electronic interface for initiating communication* with those identified persons. (emphasis added)

1.2   Rejection of Claim 2:

The Office Action rejected dependent claim 2 under 35 U.S.C. §102(e) based on the rationale that the *Appelt* reference discloses "automatically providing at least one communication access point *related to the retrieved information*." The Office Action cites *Appelt*, Fig. 12, as describing this capability. However, the Applicants would again like to point out that Fig. 12 of the *Appelt* reference is simply *a generic block diagram of a computer* that does nothing whatsoever to disclose automatic communication access points *related to the retrieved information*. Further, in response to the Applicant's arguments for patentability filed January 15, 2004, the Office Action suggests that "The system of Appelt parses electronic document and identifies people and location (Appelt, col. 9, lines 16-21). The location is an access point related to the person. A user can use the location information to contact the person."

However, the Applicant respectfully suggests that the cited text (Appelt, col. 9, lines 16-21) has been mischaracterized by the Office Action. In particular, the cited text reads as follows:

> "These are recognized by a multiword tokenizer. First, the name recognizer 302 identifies company names 'Bridgestone Sports Co.' and 'Bridgestone Sports Taiwan Co.' The names of people, locations, dates, times, and other basic entities are also recognized at this level."

Note that in the cited text, *Appelt* lists several elements as "basic entities," with each basic entity being either separated by a comma, or noted in a separate sentence. In particular, *Appelt* specifically lists the following separate basic entities:

- "company names"
- "names of people"
- "locations"
- "dates"
- "times"

Note that the basic entities of "people" and "locations" *are separated by a comma* in the cited text, as are the basic entities of "dates" and "times." Therefore, the rules of English grammar clearly dictate that these basic entities are indeed *separate* entities. The Office Action has improperly combined two such basic entities, e.g., *people*, and *locations*, to create a brand new basic entity representing the locations of identified people, and has further interpreted that new basic entity to mean a "physical address" at which to "contact that person." The Applicants respectfully suggest that this interpretation by the Office Action is wholly without support in the *Appelt* reference, and is overly broad in scope.

In contrast, throughout the Applicants specification, see paragraphs 21 and 69, for example, the Applicants describe and define communication "access points" as including, for example, "an email address, an instant messaging account, a telephone number, a fax number, a physical address, or any other means or method of communication with, or access to, the person that provides the user an access point for monitoring and/or initiating communication with that person." However, in order to clarify the language of claim 2, the Applicant has amended claim 2 to further specify that "*the at least one electronic interface for initiating communication* is displayed to a user as an icon representing at least one communication access point related to the retrieved information." (emphasis added)

Clearly, in the context of the description provided by the Applicants, "*at least one electronic interface for initiating communication* is displayed to a user as an *icon representing at least one communication access point* related to the retrieved

17

information" (emphasis added). These automatically displayed icons provide user access to an electronic interface for initiating communications with persons that are *automatically* identified within an electronic document, with that communication information being automatically retrieved from at least one electronic database external to the parsed document. This automatic capability is not disclosed by *Appelt*, and is in no way suggested by the generic block diagram of a computer provided by Fig. 12 of the *Appelt* reference.

Further, also in contrast to the position advanced by the Office Action, the Applicants respectfully suggest that the fact that the generic computer of Fig. 12 of the *Appelt* reference is connected to a network such as the Internet (as described in col. 12, lines 48-67) does nothing to disclose a capability to automatically provide the communication access points described and claimed by the Applicants. Clearly, connection to the Internet may be a precursor to some forms of electronic communication. However, a mere connection to the Internet, by itself can not serve to disclose the Applicant's claimed element relating to iconized communication access points. Therefore, it should be clear that the interpretation offered by the Office Action of a simlple Internet connection is overly broad and without support.

Finally, it should again be noted that the Applicant is in general describing and claiming a system that first identifies people by parsing a document, and then automatically retrieves information relating to those identified people from at least one electronic database. In contrast, as discussed above with respect to the rejection of claim 1, *Appelt* is describing a system which parses electronic documents to *locate information* defined during a set-up phase. This located information is then *extracted from the parsed document* and used to *populate a database* which is then made available for user query. *Appelt* simply fails to describe or in any way teach or suggest the Applicant's claimed iconized communication access points.

Consequently, in view of the preceding discussion, it is clear that the invention of dependent claim 2 has elements not taught in the *Appelt* reference. Consequently, the

rejection of claim 2 under 35 U.S.C. §102(e) is not proper. Therefore, the Applicants respectfully request reconsideration of the rejection of dependant claim 2 under 35 U.S.C. §102(e) in view of the novel language of claim 2.

In particular, claim 2 includes the following novel language:

"The system of claim 1 wherein the **at least one electronic interface for initiating communication** is displayed to a user as **an icon representing at least one communication access point related to the retrieved information**." (emphasis added)

1.3 Rejection of Claims 7-8:

Dependent claims 7-8 are generally directed towards identifying "**graphical data associated with any person**" such as an image. The Office Action suggests that the **Appelt** reference discloses this capability, and offers col. 5, lines 13-18 of the **Appelt** reference in support of this suggestion. However, as discussed above, in col. 5, lines **13-20**, **Appelt** explains that **text capture** from a media source is accomplished using a suitable converter, such as a "speech recognizer" or a "closed-caption decoder." Neither of these embodiments suggested by **Appelt** discloses any capability whatsoever to identify graphical data in the manner described and claimed by the Applicant. In fact, it should be clear that the identification of **graphical data** is **not** disclosed by a capability to parse or scan **text data**.

Further, the Office Action responded to the Applicant's arguments for patentability filed January 15, 2004 by suggesting that "**Appelt teaches the system can capture data from a multimedia source (Appelt, col. 5, lines 13-15). The multimedia source inherently includes graphical data**." (emphasis added)

Clearly, multimedia sources can include graphical data. However, the Applicant fails to understand any way in which merely including graphical data in a multimedia

19

source somehow discloses a method for identifying graphical data that is associated with particular people, as specified by claim 7. In fact, claim 8 further limits the graphical data to *images* that represent at least one person.

Appelt fails completely to offer any teaching or suggestion as to the identification of graphical data just because some multimedia source may include graphical data. Consequently, the arguments advanced by the Office Action with respect to this point are wholly without support.

Therefore, in view of the preceding discussion, it is clear that the present invention, as claimed by dependent claims 7-8, has elements not taught in the *Appelt* reference. Consequently, the rejection of claims 7-8 under 35 U.S.C. §102(e) is not proper. Therefore, the Applicants respectfully request reconsideration of the rejection of claims 7-8 under 35 U.S.C. §102(e) in view of the novel language of claims 7-8 which clearly recite and claim the identification of *graphical* data rather than *textual* data as disclosed by *Appelt*.

1.4   Rejection of Claim 24:

The Office Action rejected independent claim 24 under 35 U.S.C. §102(e) based on the rationale that the *Appelt* reference discloses the Applicants claimed "...computer-implemented process for *automatically* providing information on a computer display device ..." (emphasis added).

In particular, the Office Action cites *Appelt* as disclosing *automatically* "scanning electronic data *being rendered on the computer display device* to identify information within the electronic data that represents at least one person" (emphasis added). The Office Action offers col. 5, lines 37-43 as disclosing the capability to scan electronic data being rendered on the computer display device. However, the text in question clearly explains that:

20

"During a set-up phase, the information extraction engine 108 *parses free-text documents* to identify topics (events and relationships of interest) and objects (people, organizations and locations, among others) involved in those events and relationships. The topic and associated objects are defined and constructed by an analyst when the system 100 is set up, as discussed in more detail in FIG. 2." (emphasis added)

In stark contrast, claim 24 includes the capability to *directly scan* information that is being *rendered on a computer display device*. In view of detailed description provided in the Applicant's specification, it should be clear that this is *not* interpreted to mean that a document is first scanned and then rendered on the display device, but that the Applicant's system is *directly scanning the information being rendered on the display device itself* to identify information being rendered on that display device which represents at least one person. This embodiment is particularly useful where a document is not necessarily directly available to a computer for parsing, such as in the case where a document is viewed over a network connection (such as, for example, an Internet web page). *Appelt* appears to offer no such capability.

Further, it must be noted that in response to the Applicant's arguments for patentability filed on January 15, 2004, the Office Action of April 7, 2004 states the following:

"*It is unclear to the examiner how to scan the display device*. Therefore, the examiner interprets *the scanner scans the electronic document, not the display device*. Clearly, the system of Appelt has display and scan capabilities. *It clearly can scan electronic document displayed in the display device*." (emphasis added)

However, the Applicant respectfully suggests that the specification clearly provides an enabling description of how the information being rendered on the display device is scanned. For example, in paragraph 68 of the Applicant's specification, the Applicant

21

discusses one method in which information being rendered on a display device may be parsed or otherwise examined to identify information representing at least one person. In particular, in the working example discussed in paragraph 68, the Applicant explains that the claimed system *automatically interfaces with display rendering routines of a computer system*. The display screen of a computer is rendered in response to instructions, i.e., the display input, such as, for example compiled software code, such as a typical computer program, or, interpreted page descriptions such an HTML or similar script. Consequently, this working example essentially parses *all information viewable by the user*, as well as *hidden text or instructions*, such as, for example, hidden text embedded in the HTML code of an Internet web page, to find persons. Specifically, the working example is capable *scanning the display input looking* for known names, email addresses (using the canonical form of XXX@YYY.ZZZ), phone numbers, etc., or any data that may represent a person, as described above.

Clearly, the ability to interface with the display rendering routines of a computer system is within the ordinary ability of those skilled in the art. Therefore, the above described references to such interfaces is clearly enabling to those skilled in the art. Consequently, it should also be clear that the Examiner's interpretation of the claimed system is both in error and overly limiting. Further, it should also be clear that *Appelt* fails completely to describe, or in any way teach or suggest any system which interfaces with display rendering routines for directly "scanning electronic data *being rendered on the computer display device*," as described and claimed by the Applicant.

Consequently, in view of the above discussion, it should be clear that the *Appelt* reference fails to disclose the Applicant's claimed invention, as *Appelt* is clearly incapable of directly scanning electronic data being rendered on a display device for the purpose of identifying information within the electronic data that represents at least one person. Further, as discussed above with respect to the rejection of independent claim 1, it should also be clear that the *Appelt* reference fails to disclose the Applicants claimed elements of *"retrieving information relating to each identified person* from at least one electronic

database" and "*providing an alert for indicating that the retrieved information is available*" (emphasis added).

In addition to the above described claim elements, the Applicant has also amended independent claim 24 to further clarify the scope of claim 24. In particular, the Applicant has amended claim 24 to further include an element which recites that "at least a portion of the retrieved information relating to one or more of the identified persons to provide a user interface for initiating communication with those identified persons via at least one electronic communication access point." This element is also not taught by the Appelt reference.

Therefore, in view of the preceding discussion, it is clear that the present invention, as claimed by independent claim 24 has elements not taught in the *Appelt* reference. Consequently, the rejection of claim 24 under 35 U.S.C. §102(e) is not proper. Therefore, the Applicant respectfully requests reconsideration of the rejection of claim 24, as amended, and of dependent claims 25-30 and 35-36 under 35 U.S.C. §102(e), in view of the proceeding discussion and in further view of the novel language of claim 24, as follows:

A computer-implemented process for automatically providing information on a computer display device, comprising:

scanning electronic data being rendered on the computer display device to identify information within the electronic data that represents at least one person;

identifying each person represented by the identified information;

retrieving information relating to each identified person from at least one electronic database;

providing an alert for indicating that the retrieved information is available;

using at least a portion of the retrieved information relating to one or more of the identified persons *to provide a user interface for initiating communication*

with those identified persons via at least one electronic communication access point. (emphasis added)

1.5   Rejection of Claim 25 and 35:

Note that claims 25 and 35 have been amended to correspond to the amendments to independent claim 24. However, as discussed above with respect to the rejection of claim 24, the *Appelt* reference fails to disclose the user interface and communication "access points" as described and claimed by the Applicants. Therefore, in view of the preceding discussion, it is clear that the present invention, as claimed by dependent claims 25 and 35, has elements not taught in the *Appelt* reference. Consequently, the rejection of claims 25 and 35 under 35 U.S.C. §102(e) is not proper. Therefore, the Applicants respectfully request reconsideration of the rejection of claims 25 and 25 under 35 U.S.C. §102(e) in view of the novel language of claim 24, and in view of the preceding discussion.

1.6   Rejection of Claim 37:

The Office Action rejected independent claim 37 under 35 U.S.C. §102(e) based on the rationale that the *Appelt* reference discloses the Applicant's claimed "...computer executable instructions for dynamically modifying an electronic document *rendered on a computer display device...*"

In particular, the Office Action cites *Appelt*, col. 5, lines 37-43, as disclosing "detecting any information *in the electronic document* that represents at least one person." However, *as specifically explained and discussed in the Applicants previous response*, and as discussed above with respect to the rejection of claim 24, the Applicant's again respectfully suggest that the plain meaning of claim 37 is that an electronic document that is being *rendered on a computer display* device is automatically examined for "*detecting any information in the electronic document* that represents at least one person." This detected information is then used for "identifying each person based on a comparison of the detected information to data in at least one

24

electronic database." Finally, the Applicant's claimed invention continues by "retrieving data related to each identified person from at least one electronic database; and dynamically modifying the electronic document by changing the appearance of the electronic document for alerting a user that data related to each identified person has been retrieved."

Clearly, as with claim 24, claim 37 is describing a capability to *directly scan* information that is being *rendered on a computer display device*. In view of preceding discussion, and in further view of the detailed description provided in the Applicants' specification, it should be clear that this capability is *not* disclosed by the *Appelt* reference which explains, in col. 5, lines 37-43, that "during a set-up phase, the information extraction engine 108 *parses free-text documents*..." as disclosed by of the *Appelt* reference.

Further, as discussed above with respect to the rejection of claim 24, the Examiner contends that "It is unclear to the examiner how to scan the display device." However, as discussed above with respect to the rejection of claim 24, there is no support for this contention, as the methods described in the specification clearly enable scanning and parsing of information that is being rendered on the computer display device by *interfacing with the display rendering routines of a computer system*.

In fact, as described above, it should be clear that unlike the parsing of "free-text documents," the Applicants' claimed system is *directly scanning the data being rendered to the display device itself* to identify information being rendered on that display device, rather than merely parsing an electronic document as disclosed by *Appelt*. Thus, is should be clear that the *Appelt* reference fails to disclose the Applicants' claimed capability for directly scanning a display device to automatically identify information that represents a person, and then to act on that information by identifying the persons and retrieving information relating to those identified persons.

Further, as discussed above with respect to the rejection of claim 1, **Appelt** describes a system wherein during a "set-up phase," an "information extraction engine parses free-text documents to identify topics... and objects... defined and constructed by an analyst when the system 100 is set up..." This information is then **extracted from the parsed documents**, and then stored and organized in a database such as a relational database (see col. 5, line 37 to col. 6, line 3). The information extracted from the parsed documents for **populating the query database** is then made available to a user in response to **manual user queries**. In other words, Applicants respectfully suggest that **Appelt** does **not** retrieve "data related to each identified person from at least one electronic database," as disclosed and claimed by the Applicants. In fact, **Appelt** is instead **retrieving the information directly from the parsed document and providing it to the database** so that the user can later pass manual queries to the database populated using the information extracted from the parsed documents.

Again, in stark contrast to the system described by **Appelt**, the Applicant describes and claims a system wherein one or more persons are first **automatically** identified by parsing an electronic document. That information derived from parsing the document is then used to retrieve related information from at least one electronic database, as described in further detail below. Note that one major difference here between the claimed invention and that of **Appelt** is that **Appelt** is simply parsing a document in order to **extract information from that document** based on a set of predefined rules, with the extracted information then being used to populate a database which is then made available for subsequent manual user queries.

Consequently, in view of the above discussion, it should be clear that the present invention, as claimed by independent claim 37 has elements not taught in the **Appelt** reference. Consequently, the rejection of claim 37 under 35 U.S.C. §102(e) is not proper. Therefore, the Applicants respectfully again traverse the rejection of claim 37, and of dependent claims 38-43, 45 and 50, and request reconsideration of dependent claim 44, which has been amended to further clarify the scope of communication access points. Thus, the Applicant respectfully requests reconsideration of the rejection of claims 37-45

and 50 under 35 U.S.C. §102(e) in view of the proceeding discussion and in further view of the novel language of claim 37.

In particular, claim 37 recites the following language:

A computer-readable medium having computer executable instructions for dynamically modifying an electronic document *rendered on a computer display device*, said computer executable instructions comprising:

detecting any information in the electronic document that represents at least one person;

identifying each person based on a comparison of the detected information to data in at least one electronic database;

retrieving data related to each identified person from at least one electronic database; and

dynamically modifying the electronic document by changing the appearance of the electronic document for alerting a user that data related to each identified person has been retrieved. (emphasis added)

2.0   Rejections under 35 U.S.C. §103(a):

In the Office Action of September, 2003, claims 10 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Appelt*. In addition, claims 16-23, 31-34 and 46-49 were were rejected under 35 U.S.C. §103(a) as being unpatentable over *Appelt* in view of Appelman et al. ("*Appelman*," U.S. Patent 6,539,421).

In order to deem the Applicant's claimed invention unpatentable under 35 U.S.C. §103(a), a prima facie showing of obviousness must be made. However, as fully explained by the M.P.E.P. Section 706.02(j), to establish a prima facie case of obviousness, three basic criteria must be met. First, *there must be some suggestion or motivation*, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, *to modify the reference or to combine reference*

teachings. Second, there must be a *reasonable expectation of success*. Finally, *the prior art reference (or references when combined) must teach or suggest all the claim limitations*.

Further, in order to make a prima facie showing of obviousness under 35 U.S.C. 103(a), *all* of the claimed elements of an Applicant's invention must be considered, *especially when they are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no prima facie case of obviousness exists*. The Federal Circuit court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein (*In Re Fine*, 837 F.2d 107, 5 USPQ2d 1596 (Fed. Cir. 1988)).

2.1   Rejection of Claims 10 and 12:

Claims 10 and 12 were rejected under 35 U.S.C. §103(a) based on the rationale that *Appelt* discloses the underlying parent claim, i.e., claim 1, and that the elements of the dependent claims, i.e., claims 10 and 12 are obvious in view of *Appelt*.

However, as discussed above with respect to the rejection under 35 U.S.C. §102(e) of independent claim 1, which is the parent claim of claims 10 and 12, *Appelt* fails to teach or describe all of the elements of the Applicant's claimed invention. Therefore, any attempt to reject dependent claims based on supposed obviousness of those claims is invalid where the parent claim is shown to be patentable over the cited art. Thus, because claim 1 has been shown to be patentable over the *Appelt* reference, dependent claims 10 and 12 must also be patentable over the *Appelt* reference.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious

language of independent claim 1, as cited above. Therefore, the Applicant respectfully requests reconsideration of the rejection of claims 10 and 12 under 35 U.S.C. §103(a) over *Appelt* in view of the non-obviousness of claim 1.

2.2   Rejection of Claims 16-23:

Claims 16-23 were rejected under 35 U.S.C. §103(a) based on the rationale that *Appelt* discloses the underlying parent claim, i.e., claim 1, and that the elements of the dependent claims, i.e., claims 16 and 23 are obvious over *Appelt* in view *Appelman*.

However, as discussed above with respect to the rejection under 35 U.S.C. §102(e) of independent claim 1, which is the parent claim of claims 16-23, *Appelt* fails to teach or describe all of the elements of the Applicant's claimed invention. Therefore, any attempt to reject dependent claims based on supposed obviousness of those claims is invalid where the parent claim is shown to be patentable over the cited art. Thus, because claim 1 has been shown to be patentable over the *Appelt* reference, dependent claims 16-23 must also be patentable over the *Appelt* / *Appelman* combination where there is no valid rejection of the parent claim.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 1, as cited above. Therefore, the Applicant respectfully requests reconsideration of the rejection of claims 16-23 under 35 U.S.C. §103(a) over *Appelt* in view of *Appelman* in view of the non-obviousness of claim 1.

2.3   Rejection of Claims 31-34:

Claims 31-34 were rejected under 35 U.S.C. §103(a) based on the rationale that *Appelt* discloses the underlying parent claims, i.e., claim 24 and claim 26, and that the

elements of the dependent claims, i.e., claims 31-34 are obvious over **Appelt** in view of **Appelman**.

However, as discussed above with respect to the rejection under 35 U.S.C. §102(e) of independent claim 24, which is the parent claim of claims 26 and 31-34, **Appelt** fails to teach or describe all of the elements of the Applicant's claimed invention. Therefore, any attempt to reject dependent claims based on supposed obviousness of those claims is invalid where the parent claim is shown to be patentable over the cited art. Thus, because claim 24 has been shown to be patentable over the **Appelt** reference, dependent claims 31-34 must also be patentable over the **Appelt / Appelman** combination where there is no valid rejection of the parent claim.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 24, as cited above. Therefore, the Applicant respectfully requests reconsideration of the rejection of claims 31-34 under 35 U.S.C. §103(a) over **Appelt** in view of **Appelman** in view of the non-obviousness of claim 24, as cited above.

2.4   Rejection of Claims 46-49:

Claims 46-49 were rejected under 35 U.S.C. §103(a) based on the rationale that **Appelt** discloses the underlying parent claim, i.e., claim 37, and that the elements of the dependent claims, i.e., claims 46-49 are obvious over **Appelt** in view of **Appelman**.

However, as discussed above with respect to the rejection under 35 U.S.C. §102(e) of independent claim 37, which is the parent claim of claims 46-49, **Appelt** fails to teach or describe all of the elements of the Applicant's claimed invention. Therefore, any attempt to reject dependent claims based on supposed obviousness of those claims is invalid where the parent claim is shown to be patentable over the cited art. Thus, because claim 37 has

30

been shown to be patentable over the *Appelt* reference, dependent claims 46-49 must also be patentable over the *Appelt / Appelman* combination where there is no valid rejection of the parent claim.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 37, as cited above. Therefore, the Applicant respectfully traverses the rejection of claims 46-49 under 35 U.S.C. §103(a) over *Appelt* in view of *Appelman* in view of the non-obviousness of claim 37. Thus, the Applicant respectfully requests reconsideration of the rejection of claims 46-49 in view of the novel language of claim 37, as cited above.

CONCLUSION

In view of the above, it is respectfully submitted that claims 1-2 and 4-50 are in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of claims 1-2 and 4-50 and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (805) 278-8855 if the Examiner has any questions or concerns.

Respectfully submitted,

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31